

PATENT COOPERATION TREATY

MR

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

RAYBAUD, Hélène
Schlumberger Riboud Product Center
Intellectual Property Law Dept
1 rue Berqueral
BP 202
92142 Clamart
FRANCE

PCT

WRITTEN OPINION OF THE
INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY
(PCT Rule 66)

25/09/05

Date of mailing
(day/month/year) 25.07.2005

⑤

Applicant's or agent's file reference
WO 21.1209

REPLY DUE within 2 month(s)
from the above date of mailing

International application No.
PCT/EP2004/010848

International filing date (day/month/year)
27.08.2004

Priority date (day/month/year)
20.10.2003

International Patent Classification (IPC) or both national classification and IPC
E21B33/13

Applicant
SERVICES PETROLIERS SCHLUMBERGER et al.

- ☒ The written opinion established by the International Searching Authority:
☒ is ☐ is not
 considered to be a written opinion of the International Preliminary Examining Authority
- This second report contains indications relating to the following items:
 - ☒ Box No. I Basis of the opinion
 - ☐ Box No. II Priority
 - ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - ☐ Box No. IV Lack of unity of invention
 - ☒ Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - ☐ Box No. VI Certain documents cited
 - ☐ Box No. VII Certain defects in the international application
 - ☒ Box No. VIII Certain observations on the international application

- The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(e).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis. For an informal communication with the examiner, see Rule 66.6. For an additional opportunity to submit amendments, see Rule 68.4.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

- The final date by which the international preliminary report on patentability (Chapter II of the PCT) must be established according to Rule 66.2 is: 20.02.2006

Name and mailing address of the international preliminary examining authority:



European Patent Office
D-80299 Munich
Tel. +49 89 2369 - 0 Fax: 523655 eppu d
Fax: +49 89 2369 - 4455

Authorized Officer

Zimpler, E
Telephone No. +49 89 2369-7861



**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**

International application No.
PCT/EP2004/010848

Box No. | Basis of the opinion

1. With regard to the language, this opinion is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This opinion is based on translations from the original language into the following language, which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.9 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the elements of the international application, this opinion is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed")*:

Description, Pages

1-9

received on 30.05.2005 with letter of 26.05.2005

Claims, Numbers

1-26

received on 30.05.2005 with letter of 26.05.2005

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:
4. ☒ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☒ the claims, Nos. 1-26
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:

**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**

International application No.
PCT/EP2004/010848

Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-26
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-26
Industrial applicability (IA)	Yes: Claims	1-26
	No: Claims	

2. Citations and explanations:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Re Item I

Basis of the opinion

1. The amendments filed with the letter dated 26.05.2005 are not allowable considering Article 19(2) PCT.

The scope of amended claim 1 is broader as the content of the file as originally filed. The following feature has been added to claim 1 : "*...allowing a control of the mechanical properties independently of density of the cementing composition slurry*". However, it is not clear which mechanical properties are controlled.

In the description, it is stated on page 3, paragraph 4 : "*This invention provides cement compositions for which the mechanical properties of the set cement can be controlled independently of the slurry density.*".

Hence, claim 1 has to be limited to the "mechanical properties of the set cement", to be in accordance with Art. 19 PCT, since, without this limitation, the scope of said claim is broader than the scope of the application as originally filed.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

The following documents (D) are referred to in this communication; the numbering will be adhered to in the rest of the procedure :

- D1: EP-A-0 621 247 (SOFITECH N.V; SOFITECH N.V) 26 October 1994 (1994-10-26)
- D2: US 2003/116064 A1 (DANICAN SAMUEL ET AL) 26 June 2003 (2003-06-26)
- D3: WO 00/37387 A (SOFITECH N.V; SCHLUMBERGER CANADA LIMITED; COMPAGNIE DES SERVICES DOWE) 29 June 2000 (2000-06-29)

1. Novelty :

- 1.1 Since none of the documents cited in the search report disclose all the features of independent claim 1, it is considered that said claim as well as dependent claims 2-25 are novel over said prior art documents.

2. Inventive step :

2.1 The argumentation of the applicant has been carefully studied.

In document D1 still considered as being the closest prior art document (see p6 (36-40), one of the embodiment is a mixture comprising only cement in the fine particle size fraction (microcement).

Furthermore, it has to be noted that in the method disclosed in document D3, the mechanical properties of the cement are also adjusted independently of the density of the slurry, for slurry densities being between 12 ppg and 16 ppg (see in particular the examples).

This has also been confirmed by the applicant in the present description, on page 3, 3rd paragraph.

Hence, D3 gives already the teaching that by adding more or less flexible particles in the blend, the mechanical properties of the cement can be defined independently of the density of the slurry.

Since the subject-matter of amended claim 1 is not limited to slurry densities being smaller than 12ppg or greater than 16ppg, it is not clear how this additional feature could confer some inventive step to said claim 1 (see also the clarity objections under Item VIII).

Therefore, the subject-matter of claim 1 is not considered as being inventive over the combination D1 / D3 (or D2 / D3).

2.2 Dependent claims 2-26 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT with respect to inventive step.

Re Item VIII

Certain observations on the international application

1. The feature added to claim 1 in the present amended set of claims, even if modified to

WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY
(SEPARATE SHEET)

International application No.

PCT/EP2004/010848

limit the scope to the mechanical properties of the set cement, the wording "*..allowing a control of the mechanical properties independently of density of the cementing composition slurry*" is interpreted as a result to be achieved and not as a technical feature of the cementing slurry.

Furthermore, it is not clear to use properties of the set cement, to characterise the cementing composition slurry (Art. 6 PCT).